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09/929,430	08/13/2001	Patricia S. Kruse	10010789-1	9651

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EXAMINER

MILIA, MARK R

ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/929,430  
Filing Date: August 13, 2001  
Appellant(s): KRUSE, PATRICIA S.

\_\_\_\_\_  
Walter W. Karnstein  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed March 20, 2006 appealing from the Office action mailed September 20, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed. The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct. Further, an additional new ground of rejection appears below.

## **NEW GROUND(S) OF REJECTION**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 17-24 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

“Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.”

“Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized.”

Claims 17-24, while defining a computing device containing memory with computer-executable instructions, does not define a “computer-readable medium” and is thus non-statutory for that reasons. A computing device containing memory with computer-executable instructions can be instructions to execute a print job memorized by a person. The examiner suggests amending the claim to embody the program on “computer-readable medium” in order to make the claim statutory.

“In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure

and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." - MPEP 2106.IV.B.1(a)

### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

### **(8) Evidence Relied Upon**

5,579,087	Salgado	11-1996
6,026,416	Kanerva et al.	2-2000
5,481,353	Hicks et al.	1-1996

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 17-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, as noted above.

Claims 1, 4, 6-9, 12, 14, 15-17, 20, 22-25, 28, and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,579,087 to Salgado.

Claims 2, 10, 18, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salgado (US 5,579,087) in view of Kanerva (US 6,026,416).

Claims 3, 5, 11, 13, 19, 21, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salgado (US 5,579,087) in view of Hicks (US 5,481,353).

For completeness, the rejection, as set forth in the Final Office Action, dated 9/20/05, are duplicated below.

Regarding claims 1, 9, and 17, Salgado discloses a system comprising: adding a plurality of files to a presentation profile (see Figs. 4-6 and column 6 lines 15-42), specifying a set of individual printing characteristics with respect to each of the files (see column 5 lines 40-49), specifying a set of individual packaging characteristics with respect to each of the files (see column 7 lines 7-19), and responsive to a single print request, printing a presentation package including each of the files in the presentation profile based on the individual packaging characteristics and individual printing characteristics corresponding to each of the files (see column 5 line 66-column 6 line 14).

Regarding claim 25, Salgado discloses a user interface comprising: a first area for adding a plurality of files to a presentation profile (see Figs. 4-6 and column 6 lines 15-42), a second area for specifying a set of individual packaging characteristics with respect to individual each of the files (see column 7 lines 7-19), a third area for indicating a set of individual printing characteristics with respect to individual each of the files (see column 5 lines 40-49), and a fourth area for printing a presentation package including each of the files in the presentation profile in response to a single print request, the printing being characteristics and individual printing based on the individual packaging characteristics corresponding to each of the files (see column 5 line 66-column 6 line 14).

Regarding claims 4, 12, 20, and 28, Salgado discloses the system discussed in claims 1, 9, 17, and 25, and further discloses selecting one or more options to identify how at least one subset of the files of the presentation package are packaged, the one or more options comprising stapling the at least one subset of files together and collating the at least one subset of files (see column 5 line 66-column 6 line 14 and column 7 lines 7-19).

Regarding claims 6, 14, 22, and 30, Salgado discloses the system discussed in claims 1, 9, 17, and 25, and further discloses indicating a number of copies to print with respect to a first subset of the files that are to be included in the presentation package (see column 7 lines 11-19).

Regarding claims 7, 15, 23, and 31, Salgado discloses the system discussed in claims 1, 9, 17, and 25, and further discloses identifying a specific printer to print each of the files (see column 6 line 54-column 7 line 10).

Regarding claims 8, 16, 24, and 32, Salgado discloses the system discussed in claims 1, 9, 17, and 25, and further discloses indicating which of a plurality of print media supply bins are to be used by a printer to print individual ones of the files (see Fig. 1 (11), column 5 lines 40-49, and column 7 lines 11-19, reference states that the user can specify the type of paper stock which inherently comes from a media supply bin).

Regarding claims 2, 10, 18, and 26, Salgado does not disclose expressly wherein a first subset of the files were generated using a first computer program

application, and wherein a second subset of the files were generated using a second computer program application that is different than the first computer program application.

Kanerva discloses wherein a first subset of the files were generated using a first computer program application, and wherein a second subset of the files were generated using a second computer program application that is different than the first computer program application (see column 6 lines 11-16, column 9 lines 28-34, column 10 lines 46-51, and column 13 lines 18-23).

Salgado & Kanerva are combinable because they are from the same field of endeavor, printing compound documents containing a plurality of individual job segments.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the use of subsets containing files generated from different computer program applications as described by Kanerva with the system of Salgado.

The suggestion/motivation for doing so would have been to allow different kinds of documents to be processed and printed together to increase efficiency and grant the user greater control (see column 1 lines 12-35 and column 3 lines 30-60 of Kanerva).

Therefore, it would have been obvious to combine Kanerva with Salgado to obtain the invention as specified in claims 2, 10, 18, and 26.

Regarding claims 3, 11, 19, and 27, Salgado does not disclose expressly identifying a first subset of the files that are to be included in the presentation package



and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files.

Hicks discloses identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files (see column 7 line 10-column 11 line 6, particularly column 8 lines 25-34, column 9 lines 60-67, and column 10 line 1-column 11 line 6).

Regarding claims 5, 13, 21, and 29, Salgado discloses indicating a number of copies to print with respect to a first subset of the files that are to be included in the presentation package (see column 7 lines 11-19).

Salgado does not disclose expressly identifying a subset of files that are to be included in a general distribution package and indicating a number of copies to print with respect to the subset of the files that are to be included in the general distribution package.

Hicks discloses identifying a subset of files that are to be included in a general distribution package and indicating a number of copies to print with respect to the subset of the files that are to be included in the general distribution package (see Figs. 3 and 4, column 8 lines 25-35, and column 9 line 60-column 11 line 6).

Salgado & Hicks are combinable because they are from the same field of endeavor, printing compound documents containing a plurality of individual job segments.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the use of subsets to categorize files for distribution and presentation as described by Hicks with the system of Salgado.

The suggestion/motivation for doing so would have been to provide increased flexibility and efficiency in producing compound documents for distribution.

Therefore, it would have been obvious to combine Hicks with Salgado to obtain the invention as specified in claims 3, 5, 11, 13, 19, 21, 27, and 29.

#### **(10) Response to Argument**

Applicant's arguments regarding the rejection of claims 1, 4, 6-9, 12, 14, 15-17, 20, 22-25, 28, and 30-32, especially independent claims 1, 9, 17, and 25, have been fully considered but they are not persuasive.

In response to the applicant's arguments, on pages 8-17, the applicant asserts that the reference of Salgado fails to disclose, "specifying individual packaging characteristics". The examiner respectfully disagrees for the following reasons. First, Salgado shows in Figure 5 and column 6 lines 54-62 that each selected job segment has an associated print destination, i.e. printer or fax machine. Also, associated with each job segment are print job characteristics (see column 5 lines 41-49) such as paper stock, quantity (see abstract), and quality. In particular, quantity, i.e. number of copies, is a packaging characteristic. Secondly, Salgado also states that job requirements, i.e. quantity, quality, and finishing mode requirements, can be compiled at a remote storage or memory location on the network for later printing at the location of the storage device

or printing at another designated printer on the network. In other words, selected remote files can be reproduced at different destinations or compiled at any given location for later retrieval and printing at another remote location (see column 7 lines 3-10). Salgado discloses a system in which each job segment can potentially be printed by a different printing device/destination and therefore each segments carries with it an associated packaging characteristic to enable proper execution, the packaging characteristics being set by the user. Still further, column 7 lines 11-53 show that each segment can be reproduced separate from any other segment. In other words, even though the segments are all part of a bigger job, each segment has it's own printing and packaging characteristics that allow the segment to be printed by a number of different out devices.<sup>6</sup>

In response to the applicant's arguments, on pages 17-20, the applicant asserts that combining Kanerva with Salgado would not have been obvious. The examiner respectfully disagrees because Kanerva and Salgado disclose similar inventions. Particularly, Kanerva discloses a system in which binder document sections, documents from different applications, are organized as a single binder document, known as a binder file. The binder file can then be selected for printing, in which each binder document section is printed by dispatching commands to each of the application program modules that created the document (see column 17 lines 11-25). Salgado states that each segment can have a different format. This is analogous to the binder document sections that are from different applications as disclosed by Kanerva.

Therefore, it would have been obvious to combine Kanerva with Salgado, as both inventions are similar in scope and execution.

In response to the applicant's arguments, on pages 21-25, the applicant asserts that combining Hicks with Salgado does not disclose each recited feature of claims 3, 5, 11, 13, 19, 21, and 29. The examiner respectfully disagrees, as each feature is disclosed by the combination of Salgado and Hicks. Particularly, with regard to claims 3, 11, 19, and 27, Hicks discloses "identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files" (see column 7 line 10-column 11 line 6). Hicks shows that there are four different document types which are analogous to subsets of files as recited in the above limitations, also the subsets contain different information even though the information is based on the master document, as the other documents can contain additional information or less information, and the different document types can be printed in different output stacks, some being for general distribution "handout set" and some being for the presentation package "transparency set". With regard to the remaining claims, the above argument applies as the reference of Hicks discloses identifying subsets and indicating a number of copies to be printed (see column 9 lines 60-67).

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

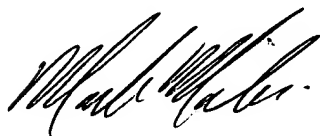
This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte dismissal of the appeal* as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mark R. Milia', written in a cursive style.

Mark R. Milia

Art Division 2625

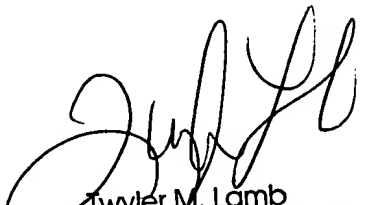
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Art Unit: 2625

**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**


Conferees:

Twyler Lamb



Twyler M. Lamb  
Supervisory Patent Examiner

Kimberly Williams



KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER